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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/853,430	05/10/2001	Philip M. Ginsberg	CF/019	6761
64558 7590 12/31/2007 ROPES & GRAY LLP PATENT DOCKETING 39/361 1211 AVENUE OF THE AMERICAS NEW YORK, NY 10036-8704			EXAMINER AKINTOLA, OLABODE	
			ART UNIT 3691	PAPER NUMBER
			MAIL DATE 12/31/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/853,430

Applicant(s)

GINSBERG ET AL.

Examiner

Olabode Akintola

Art Unit

3691

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-13, 17-26, 28-30, 32-39 and 44-60 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4-13, 17-26, 28-30, 32-39 and 44-60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 10/09/2007.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Art Unit: 3691

Claims 4-13, 17-26, 28-30, 32-39 and 44-60 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-29 of copending Application No. 11/562674 and claims 1-28 of copending Application No. 11/562719. Although the conflicting claims are not identical, they are not patentably distinct from one another.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 4-8, 17-21, 38-39 and 44-46 are rejected under 35 U.S.C. 102(b) as being anticipated by Togher et al (USPN 6014627).

Re claims 4, 17, 38-39 and 44-46: Togher teaches a method comprising: causing to be presented to at least a respective first trader and second trader an interface comprising a plurality of options on how the respective trader wants a trading system to process pending trades that cause warning limits to be exceeded, the plurality of options including: the trading system automatically rejecting the pending trades (col. 3, lines 1-20: “*the entire transaction could be blocked*”),

Art Unit: 3691

the trading system automatically executing in part the pending trades such that the executed in part trades do not cause the warning limits to be exceeded (col. 3, lines 1-20, Fig. 6: “*if either of the two applicable limits has not already been exceeded between a pair of counterparties*” and “*Preauthorization matrix*”), and

the trading system automatically executing in full the pending trades (col. 3, lines 1-20: “*the entire transaction could be executed*”);

receiving from each of the first trader and the second trader a selection of one of the plurality of options;

in addition to the selection of the first trader, receiving from the first trader a first warning limit specified against the second trader (col. 3, lines 1-20: *counterparty limit*);

in addition to the selection of the second trader, receiving from the second trader a second warning limit specified against the first trader (col. 3, lines 1-20: *counterparty limit*);

after receiving the selection of the first trader, the selection of the second trader, the first warning limit, and the second warning limit:

receiving at the trading system a first order from the first trader; and receiving at the trading system a second order from the second trader;

in which the first order and the second order result in a pending trade between the first trader and the second trader;

determining whether that execution of the pending trade between the first trader and the second trader causes at least one of the first warning limit and the second warning limit to be exceeded;

Art Unit: 3691

processing the pending trade between the first trader and the second trader based on the selection of the first trader and the selection of the second trader, in which processing the pending trade comprises at least one of:

the trading system automatically rejecting the pending trade, the trading system automatically executing in part the pending trade such that the executed in part trade does not cause the first warning limit nor the second warning limit to be exceeded, and

the trading system automatically executing in full the pending trade (col. 3, lines 1-20).

Re claims 5 and 18: Togher teaches in which at least one of the selection of the first trader and the selection of the second trader comprises the option of the trading system automatically rejecting the pending trades; in which processing the pending trade between the first trader and the second trader based on the selection of the first trader and the selection of the second trader comprises the trading system automatically rejecting the pending trade (col. 3, lines 1-20)

Re claims 6 and 19: Togher teaches in which the selection of the first trader and the selection of the second trader comprises the option of the trading system automatically executing in part the pending trades; in which processing the pending trade between the first trader and the second trader based on the selection of the first trader and the selection of the second trader comprises the trading system automatically executing in part the pending trades such that the executed in part trade does not cause the first warning limit nor the second warning limit to be exceeded (col. 3, lines 1-20).

Art Unit: 3691

Re claims 7 and 20: See claim 4 analysis, supra.

Re claims 8 and 21: Togher teaches in which at least one of the selection of the first trader and the selection of the second trader comprises the option of the trading system automatically executing in full the pending trades; in which processing the pending trade between the first trader and the second trader based on the selection of the first trader and the selection of the second trader comprises the trading system automatically executing in full the pending trades (col. 3, lines 1-20).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 47-60, 9-13, 22-26, 28-30, 32-37, are rejected under 35 U.S.C. 103(a) as being unpatentable over Togher in view of Gatto (5546523) (Gatto).

Art Unit: 3691

Re claims 47 and 48: Togher does not explicitly teach the use of prompt for executing trades. Gatto teaches the use of prompt for executing trades (col. 6, lines 60 through col. 7, line 3). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Togher to include this feature. One would have been motivated to do in order verify the user's desired option.

Re claims 9 and 22: See claims 6 and 47-48 analyses, supra.

Re claims 10, 23, 33, 34, 52 and 55: See claims 7 and 47-48 analyses, supra.

Re claims 11, 24, 35, 36, 37 and 57-59: See claims 8 and 47-48 analyses, supra.

Re claims 12 and 25: See claims 4, 17 and 47-48 analyses, supra.

Re claims 13 and 26: See claims 4, 17 and 47-48 analyses, supra.

Re claims 29 and 54: See claims 8 and 47-48 analyses, supra.

Re claims 28 and 30: See claims 6 and 47-48 analyses, supra.

Re claims 32, 53 and 56: See claims 4 and 47-48 analyses, supra.

Re claim 49: See claims 6 and 47-48 analyses, supra.

Re claim 50 and 60: See claims 4 and 47-48 analyses, supra.

Re claim 51: See claims 8 and 47-48 analyses, supra.

Response to Arguments

Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olabode Akintola whose telephone number is 571-272-3629. The examiner can normally be reached on M-F 8:30AM -5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3691

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

OA



HANI M. KAZIMI
PRIMARY EXAMINER